

REMARKS

Claims 1-52 are pending in the Office Action. By this Amendment, Claims 41-52 are added.

Applicants gratefully acknowledge the indication in the Office Action that Claims 3, 8, 13 and 27 contain allowable subject matter.

In the Office Action, the Examiner asserts that the Declaration filed on 17 April 2000 is defective, and requires a new Declaration. This assertion and requirement are respectfully traversed.

The second-named inventor, Donald J. Lindsay, in addition to adding his signature to the Declaration on 10 April 2000, also wrote in his citizenship as "Canadian". Mr. Lindsay wrote in his citizenship at the time he signed the Declaration. Applicants note that MPEP § 602.01 indicates that an Oath or Declaration cannot be altered in any way *after* it has been signed. Since Mr. Lindsay wrote in his citizenship at the time he signed the Declaration, the Declaration is fully consistent and in compliance with the policy set forth in MPEP § 602.01. 37 C.F.R. § 1.52(c)(1) indicates any alteration of the application papers *must* be made before the signing of an accompanying declaration, and the alteration *should* be dated and initialed or signed by the application on the same sheet of paper. Applicants have two observations. First, use of the word "should" instead of the word "must" indicates that dating and initialing or signing is desired by the Patent Office but not mandatory. Second, Mr. Lindsay's signature and date of signature are directly adjacent his indication of Canadian citizenship, on the same page. Accordingly, Applicants respectfully submit that the filed Declaration satisfies all requirements and policies set forth in 37

C.F.R. § 1.52(c) and MPEP § 602.01. Withdrawal of the objection to the filed Declaration is respectfully requested.

In the Office Action, the Examiner rejects Claims 30-32 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,169,538 to Nowlan (Nowlan). This rejection is respectfully traversed. In the Office Action near the center of the page 4, immediately prior to the discussion of U.S. Patent No. 5,564,004 to Grossman (Grossman), the Examiner acknowledges that Nowlan fails to teach storing icon data representative of a plurality of icon images. This feature is recited in Claim 30. Accordingly, as acknowledged by the Examiner, Nowlan fails to disclose or suggest all of the features recited in Claims 30-32. For at least this reason, withdrawal of the rejection of Claims 30-32 under 35 U.S.C. § 102(e) over Nowlan is respectfully requested.

In the Office Action, the Examiner rejects Claims 1-2, 4-7, 9-12, 14-26, 28-29, and 33-40 under 35 U.S.C. § 103(a) over a combination of Nowlan and Grossman. This rejection is respectfully traversed.

In the Office Action near the center of page 4, the Examiner acknowledges that Nowlan fails to disclose or suggest storing icon data representative of a plurality of icon images, as recited in the independent claims. The Examiner goes on to assert that Grossman discloses this feature, and it would have been obvious to combine Nowlan with Grossman because doing so would allow users to access icons that are more likely to accessed, with greater ease, thus allowing easier navigation through complex sets of icons during the selection process disclosed in Nowlan. This assertion is respectfully traversed, because the Examiner has not explained specifically how Nowlan's system would be

combined with Grossman's teachings, or why a person of ordinary skill in the art would have desired such a combination.

Nowlan discloses a system wherein as a user drags a pointer across a graphical user interface keyboard, the character or key beneath the point is enlarged, along with characters immediately adjacent the character underneath the pointer. See for example Figures 6-7 and column 4, line 60 to column 5, line 28. If the pointer is lifted, the key beneath the pointer is accepted as a text character. See for example column 4, lines 3-5. In this way a user can compose text, as shown for example in Figure 3. The zooming feature shown in Figures 6-7 helps the user identify the character beneath the pointer, which can be especially useful when the un-zoomed size of the character is small and hard to see (refer to column 1, lines 12-22).

However, the Examiner has not demonstrated precisely *how* the teaching of Grossman would aid a user of Nowlan's system, and therefore has not provided motivation that would have caused one of ordinary skill in the art at the time of the invention, to combine Nowlan and Grossman. For example, Nowlan's system shows a keyboard whose configuration is consistent and familiar to the user, as for example a QWERTY keyboard for typing. In other words, the relative placement of the characters/keys is important because they are hard to see, and a user benefits from having a general idea of where the different characters are so he can direct the pointer to enlarge an area where he knows the character can be found. In addition, as can be seen from Figures 6-7, the expanded or zoomed characters cover many of the unexpanded characters, so that a character should only be zoomed or expanded when the pointer is on the character or an adjacent character.

Otherwise, the system would be cumbersome and difficult to use. What specific features of Nowlan's system would a person of ordinary skill in the art have altered using the teachings of Grossman? The Examiner's general statement provides no specific guidance as to how Nowlan's system would be different after being modified with teachings from Grossman, and fails to demonstrate why any such change would be an improvement desired and recognized by one of ordinary skill in the art. In summary, the Examiner has not provided sufficient motivation to combine Nowlan and Grossman, and therefore has failed to set forth a *prima facie* case of obviousness with respect to the independent claims.

In addition, Applicants respectfully submit that Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest all of the features recited in the dependent Claims.

For example, Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest that the object characteristic is a size of the object, as recited in Claim 41, and similar features recited in Claims 45 and 49.

Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest that the object characteristic is an amount of memory that the object uses, as recited in Claim 42, and similar features recited in Claims 46 and 50.

Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest that the object characteristic is a number of files in the object, as recited in Claim 43, and similar features recited in Claims 47 and 51.

Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest that the object characteristic is a measure of how recently the object


was added or amended, as recited in Claim 44, and similar features recited in Claims 48 and 52.

For at least the above reasons, Applicants respectfully submit that Nowlan and Grossman, when considered both separately and in combination, fail to disclose or suggest all of the features recited in the pending claims. Withdrawal of the rejection of Claims 1-2, 4-7, 9-12, 14-26, 28-29, and 33-40 under 35 U.S.C. § 103(a) over the combination of Nowlan and Grossman is respectfully requested.

Applicants respectfully submit that the application is in condition for allowance. Favorable consideration on the merits and prompt allowance are respectfully requested. In the event any questions arise regarding this communication or the application in general, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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